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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,052	08/28/2001	Jorg Schlieffers	1206	5662

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[REDACTED] EXAMINER

LEE, DIANE I

ART UNIT	PAPER NUMBER
	2876

DATE MAILED: 08/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/941,052	SCHLIEFFERS, JORG	
	<b>Examiner</b>	<b>Art Unit</b>	
	D. I. Lee	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 July 2003.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 19-25 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 19-25 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_ .

## **DETAILED ACTION**

1. Receipt is acknowledged of the Amendment filed 02 July 2003. All previous claims (i.e., claims 1-18) have been canceled; and claims 19-25 have been newly added. Currently, claims 19-25 are pending in this application.
2. The examiner has noted that applicant has canceled the "Reference to Related Applications" by the applicant's response filed 02 July 2003 (see page 2, lines 1+). Therefore, it appears that applicant is no longer claiming the domestic priority of benefit under 35 U.S.C. Section 120 and/or 121. Accordingly, the PTO record has been updated to reflect the applicant action.

### ***Claim Objections***

3. Claim 24 is objected to because of the following informalities:
  - (a) Re claim 24, line 1: "longitudinal" should be changed to --longitudinal direction of the body--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
5. Claims 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reynolds et al. [US 5,828,052-referred as Reynolds] in view of Evers et al. [US 6,036,096-referred as Evers].  
  
Re claims 19-22: Reynolds discloses a reader for electro-optically reading indicia (a scanner 20), comprising:

a housing having a body portion extending along a longitudinal direction to one end region (i.e., a head portion 22) of the housing, a light-transmissive window 64 at said one end region, and a handled portion 26 extending along a handle direction to an opposite end region of the housing (see figure 3);

a scanner (a scan engine, not shown, contained in the housing) mounted within the housing for electro-optically scanning the indicia with light passing through the window (see figure 5+);

a first resilient member (i.e., the upper bumper 34, 66 of elastomers to protect underlying surface of the scanner) mounted at said one end region and constituted of a hard rubber, thus the first resilient member constitute a first resting surface;

a second resilient member (i.e., lower bumper 34' and end cap 28) mounted at the opposite end region and extending away from the handle portion, said second resilient member having a bottom edge constituting a second resting surface, which together with the first resting surface from the first resilient member, support the housing on a generally planar support surface when the handle portion is not held by a user; and

an eyelet (i.e., an opening, shown in figures 5-6, 8-9 but the specific reference number not assigned) extending from the second resilient member, for alternatively supporting the housing when the handle portion is not held by the user (i.e., the opening at the end cap of the reader may be optionally used for suspending the reader from a support projection such as a nail, a hook, and etc. when not scanning).

Although Reynolds shows the forwardly extending portion 66 of the first resilient member serves the claimed function for spacing the window at a given minimum distance from the indicia to be read (see figures 5-6, for example); Reynolds fails to show the specifics of the claimed first resilient member and the spacer, i.e., the first resilient member being an annular, surrounding the window, and having upper, lower and side edges extending along the longitudinal direction past the window away from the body portion, the side edges extending further from the window than the upper and lower edges to constitute a first resting surface; and the spacer is integral with the lower edges and is concavely curved.

Evers discloses a hand-held imager 10, comprising a housing 11 having a body portion extending along a longitudinal direction to one end region (i.e., a head portion 12, 20) of the housing, a light-transmissive window 22 at said one end region, and a handled portion 14 extending along a handle direction to an opposite end region of the housing (see figure 3). The hand-held imager having a scanner (a scan engine, not shown, contained in the housing) mounted within the housing for electro-optically scanning the indicia with light passing through the window (see figure 1). The hand-held imager further includes a first resilient member (i.e., an end cap 26) mounted at said one end region 12, 20 and constituted of a hard rubber (see col. 4, lines 8+). The first resilient member being an annular, surrounding the window, and having upper, lower and side edges extending along the longitudinal direction past the window away from the body portion to constitute a first resting surface (see figures 1-6). The hand-held imager further includes a spacer (the spacer is integral with the lower edges of the first resilient member) on the first resilient member for spacing the window at a given minimum distance from the indicia to be read and a second resilient member (i.e., end member 36 with a flexible coupling 72) mounted at the opposite end region and extending away from the handle portion, said second resilient member having a bottom edge constituting a second resting surface, which together with the first resting surface from the first resilient member, support the housing on a generally planar support surface when the handle portion is not held by a user (see col. 6, lines 32+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the specific structure of the first resilient member, as taught by Evers, in the system of Reynolds in order to improve the configuration shape of the scanner, i.e., improving the supporting surfaces that allow a secure positioning of the scanner on a flat surface or on a generally a planar surface whereby the handle can be grasped easily by an operator (see col. 2, lines 37+). Such modification in the construction of the housing would have ergonomically enhanced in manipulating and handling of the scanner.

Reynolds as modified by Evers fails to teach the side edges first resilient member extending further from the window than the upper and lower edges to constitute a first resting surface, the lower, the upper edges, and the spacer are convexly curved.

However, the fact that Reynolds as modified by Evers discloses the first resilient member having upper, lower and side edges extending along the longitudinal direction past the window away from the body portion would have constituted a first resting surface of the scanner without the side edges extending further from the window than the upper and lower edges; the specific shape of the components (i.e., the side edges extending further from the window than the upper and lower edges and the specific shape of the upper and lower edges and the shapes of the edges; and the convexly curved shape of the spacer) would have been obvious design variation to provide variable shape and size of the components for an esthetic purpose, since such a modification would have involved a mere changing the shape and the size of a component. A change in size and shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 UAPQ 237 (CCPA).

Re claim 23: Wherein the eyelet extends along the handle direction through the second resilient member (see figures 5-6 and 8-9).

Re claim 24: Reynolds and Evers both show the scanner body of the longitudinal and handle directions form an obtuse angle with each other (i.e., the handle is slanted with respect to the head body).

Re claims 25: a trigger 60 on the handle portion, for manually actuating the scanner when the handle portion is held by the user (see col. 4, lines 20+ and figures 3-6).

#### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,123,265 in view of Reynolds [US 5,828,052] and Evers [US 6,036,096]. The teachings of Reynolds and Evers have been discussed above.

Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,123,265 teaches all claimed limitation of the instant application except for the specifics of the first and the second resilient members, an eyelet, and a spacer.

Reynolds teaches a laser scanning bar code reader with a first and the second resilient members and the eyelet (see the discussion above).

Evers teaches a hand-held imager with a spacer (see the discussion above).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Reynolds and Evers in the teaching of U.S. Patent No. 6,123,265 in order to further improve the structural design of the reader.

#### ***Response to Arguments***

8. Applicant's arguments with respect to the first resilient member and the second resilient member in claim 19 have been considered but are moot in view of the new ground(s) of rejection (see the discussion above).

#### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Sakai [US 4,210,802] and Matsushima et al. [US 4,818,856] discloses a hand-held body with a first member having a structure similar to the applicant's claimed invention.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is 703-306-3427. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.



D. I. Lee  
Primary Examiner  
Art Unit 2876

D. L.  
August 14, 2003